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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,246	02/11/2004	Daniel Willis	16113-682001	1097
26192 7590 07/31/2008 FISH & RICHARDSON P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022				
EXAMINER				
LASTRA, DANIEL				
ART UNIT		PAPER NUMBER		
3688				
MAIL DATE		DELIVERY MODE		
07/31/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/775,246

Applicant(s)

WILLIS, DANIEL

Examiner

DANIEL LASTRA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-25 have been examined. Application 10/775,246 (ADVERTISING ON VIDEO EVENT DISPLAY SYSTEMS) has a filing date 02/11/2004 and is a continuation in part of 10232603, filed 09/03/2002.

Response to Amendment

2. In response to Non Final Rejection filed 12/28/2007, the Applicant filed an Amendment on 04/28/2008, which amended claims 1-9, 12, 15, 16 and added new claims 17-25.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Ebisawa (US 5,946,664).

Claims 1, 9, 16 and 17, Ebisawa teaches:

A method of advertising comprising :

receiving an identification from a video event display system (see col 2, lines 23-30 "game identification code"), *wherein the identification received from the video event display system comprises information identifying one or more of the video event display*

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system or a user of the video event display system (see col 2, lines 22-27; col 7, lines 1-10; "game identification code");

providing an advertisement from *one or more available* advertisements to the video event display system for displaying the advertisement on the video event display system (see col 2, lines 30-35);

providing a video event to be displayed on the video event display system (see col 3, lines 20-35); and

displaying the advertisement *with video event* on the video event display system (see col 3, lines 20-35; figures 1a, 1b, 2a, 2b).

Claims 2, 10 and 18, Ebisawa teaches:

wherein the advertisement is a static advertisement (see col 3, lines 20-35).

Claims 3, 11 and 19, Ebisawa teaches:

wherein the advertisement is an animated advertisement (see col 3, lines 50-65 "Ads A, C are replaced by ads B, D").

Claims 4, 12 and 20, Ebisawa teaches:

wherein the advertisement is displayed in a designated advertising space, the designated advertising space being selected in connection with the video event (see figures 1a, 1b, 2a, 2b).

Claims 5, 13 and 21, Ebisawa teaches:

wherein the designated advertising space is incorporated into the video event (figures 1a, 1b, 2a, 2b).

Claims 6, 14 and 22, Ebisawa teaches:

wherein the identification received from the video event display system includes information about the video event (see col 6, lines 60-67 “identification data identifies the game program stored on the optical disk”).

Claims 7 and 15, Ebisawa teaches:

wherein the advertisement out of the *one or more available* advertisements is selected according to specifications provided by the video event (see col 5, lines 20-30).

Claim 8, Ebisawa teaches:

wherein the video event display system comprises either one of set-top box, a gaming console, or a set-top box gaming system (see col 1, lines 15-20).

Claims 23-25, Ebisawa teaches:

wherein the video event is a single-user game, a multi-player game, or a movie (see col 5, lines 15-45).

Response to Arguments

4. Applicant's arguments filed 04/28/2008 have been fully considered but they are not persuasive. The Applicant argues that Ebisawa does not teach “*wherein the identification received from the video event display system comprises information identifying one or more of the video event display system or a user of the video event display system*”. The Examiner answers that Ebisawa teaches transmitting game identification data from a game system to an online service provider and using said identification data to transfer to the game system updated variable data which either is advertisement data or advertisement selection code (see col 7, lines 1-10). Therefore, contrary to Applicant's argument, Ebisawa teaches receiving from the video display

system (i.e. "game system") information identifying one or more of the video display system (i.e. "game identification data").

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **DANIEL LASTRA** whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **ERIC W. STAMBER** can be reached on 571-272-6724. The official Fax number is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Raquel Alvarez/
Primary Examiner, Art Unit 3688

/DANIEL LASTRA/
Art Unit 3688
July 28, 2008